

B¹⁰

142. The compound of claim 132, wherein one R group is selected from the group consisting of hydrogen, C₁-C₃ alkyl, C₁-C₃ alkoxy, hydroxyl, -COCF₃, C₁-C₆ alkanoyl, Cl, F, Br, I, C₁-C₃ alkylamino, -NO₂, -CF₃, -OCF₃, and -C(=O)-lower alkyl.



REMARKS

In this amendment, Patent Owner has amended claims 1, 26, 52-59, 65, 66, 74, 77-86, 98, 114, 132, and 142. Claim 76 was deleted, and claims 87-147 were added by Preliminary Amendment dated November 15, 2000. Thus, claims 1-75 and 77-147 are pending.

The Examiner has indicated that claims 1-75 and 77-147 are rejected. Claims 1, 26, 77, 79, 80, 82-86, 98, 114, 132, and 142 have been amended to correct typographical errors noted by the Examiner on pages 3-5 of the Office Action. No new matter has been added and Patent Owner respectfully requests entry of the amendment. Claim 59 has been amended to make it an independent claim and remove the rejection for lack of antecedent basis for the benzyloxy limitation. Support for claim 59 may be found in Example 85; thus, no new matter has been added and Patent Owner respectfully requests entry of the amendment. Claim 65 has been amended to correct a typographical error in the nomenclature. Support for claim 65 may be found in Example 147 (B); thus, no new matter has been added and Patent Owner respectfully requests entry of the amendment. Claim 74 has been amended to remove the hydroxy and halogen groups from the definition of Y and remove the rejection for lack of antecedent basis for these limitations. No new matter has been added, and Patent Owner respectfully requests entry

of the amendment.

Reissue Declaration

The Examiner has found the reissue declaration filed with the instant reissue application to be defective because it allegedly (a) fails to state that the applicants are the original **and first** inventors, (b) fails to identify the city and state of residence of each inventor, and (c) does not recite an error with sufficient specificity. Claims 1-75 and 77-147 have been rejected as being based upon a defective reissue declaration.

Applicants herein provide a replacement reissue declaration that includes the “original and first joint inventors” language as well as the city and state of residence of each inventor. The replacement reissue declaration also provides a specific error with respect to the claim language in accordance with MPEP § 1414. With respect to the inventor residence requirement, Patent Owner notes that the residence of each inventor was included in the Application Data Sheet that was filed with the instant reissue application pursuant to 37 C.F.R. § 1.76. However, in order to expedite the instant reissue application and since a supplemental reissue declaration has been prepared, that residence information has been reproduced in the supplemental reissue declaration. With respect to the Examiner’s comment that the reissue declaration “does not recite error with sufficient specificity, i.e. what compounds are taught by the prior art,” Patent Owner respectfully submits that the statement found in paragraph 5 of the reissue declaration dated November 15, 2000, is sufficient. However, in order to expedite the instant reissue application, Patent Owner has amended the statement in paragraph 5 to recite specific claim language in the original patent that is an error.

Rejections under 35 U.S.C. § 112

A. Rejections under 1st Paragraph of § 112

Claims 78 and 82-86 have been rejected for allegedly lacking written description of the claimed subject matter where R is alkanoyl. Patent Owner respectfully submits that the definition of R as alkanoyl may be found in the instant specification (disclosure of U.S. Pat. No. 5,364,866) at the bottom of column 24, seven lines up from the bottom, and in great, great grandparent Application No. 06/456,790, filed December 29, 1989, on page 8, line 11.

Accordingly, Patent Owner respectfully requests that the rejection be withdrawn.

B. Rejections under 2nd Paragraph of § 112

Patent Owner thanks the Examiner for her attention to the details of the complicated claim language in the instant reissue application. In the foregoing amendment, Patent Owner has addressed the various typographical errors noted by the Examiner in claims 1, 26, 77, 79, 80, 82-86, 98, 114, 132, and 142. With respect to claim 59 (item (h) on page 4 of Office Action), Patent Owner has amended claim 59 to be independent. Support for the compound recited in claim 59 may be found in Example 85. With respect to claim 74 (item (i) on page 4 of Office Action), Patent Owner has amended claim 74 to remove the hydroxy and halogen groups in the definition of Y.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 78 and 82-86 under 35 U.S.C. § 102(b) as allegedly anticipated by Strupczewski et al. (EP 402,644). The Examiner states that claims 78 and 82-86

have not been accorded benefit of applications filed prior to the October 30, 1992, filing date of Appln. No. 07/969,383 (the application that matured into the '866 patent upon which the instant reissue application is based). As stated above, however, Patent Owner submits that the definition of R as alkanoyl may be found on page 8, line 11 of Appln. No. 06/456,790, filed December 29, 1989. Thus, since claims 78 and 82-86 are entitled to a priority date of December 29, 1989, they can not be anticipated by Strupczewski, which was published on December 19, 1990. Accordingly, Patent Owner respectfully requests that the rejection be withdrawn.

For the foregoing reasons, Patent Owner respectfully submits that claims 1-75 and 77-147 are in condition for allowance, and early notification to this effect is courteously requested.

As noted in the Consent of Assignee, Offer to Surrender Original Patent, and Statement under 37 C.F.R. § 3.73(b) filed November 15, 2000, Patent Owner intends to surrender the original Letters Patent when the reissue application is in condition for allowance.

If there are any fees due in connection with the filing of this response not already accounted for, please charge the fees to our Deposit Account No. **18-1982**.

Respectfully submitted,

By: 
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#6

PATENT

Attorney Docket No. 2489.0028-11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
U.S. Patent No. 5,364,866)
Joseph T. STRUPCZEWSKI et al.)
Reissue Serial No.: 09/712,129)
Filed: November 15, 2000)
For: HETEROARYLPIPERIDINES,)
PYRROLIDINES AND PIPERAZINES AND)
THEIR USE AS ANTIPSYCHOTICS)
AND ANALGETICS)

Group Art Unit: 1624

Examiner: B. Coleman

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deposited with the United States Postal Service as
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Commissioner for Patents, Washington, D.C. 20231
on

6-13-02

Date of Deposit

Genelia Walker

BOX REISSUE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REISSUE DECLARATION UNDER 37 C.F.R. § 1.175

We, Joseph T. Strupczewski, Grover C. Helsley, Yulin Chiang, Kenneth J. Bordeau, and Edward J. Glamkowski, all citizens of the United States with residences and post office addresses as listed below, do hereby state and declare as follows:

1. We believe we are the original and first joint inventors of the subject matter which is described and claimed in United States Patent No. 5,364,866, granted on November 15, 1994, and for which a reissue patent is sought on the invention entitled, "Heteroarylpiperidines, Pyrrolidines and Piperazines and Their Use as Antipsychotics and Analgetics."

**Reissue Application of
Patent No. 5,364,866
Atty. Docket No. 2489.0028-11**

2. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the original patent claims, and the claims in the Preliminary Amendment filed November 15, 2000, and the Amendment filed herewith.

3. We acknowledge the duty to disclose information that is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

4. We believe that U.S. Patent No. 5,364,866 is at least partially inoperative or invalid because, without any deceptive intention, we claimed more or less than we had the right to claim in the patent.

5. An error which is a statutory basis for reissue is that at least some of the patent claims that recite R₂₀ in the definition of R₁ cover subject matter described in European Patent Application No. 402,644 (EP <644) published December 19, 1990. Applicants are filing this Reissue Application in order to overcome this reference.

6. The above-described error and all other errors corrected in this reissue application arose without any deceptive intent.

7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

**Reissue Application of
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United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Full Name of Third Inventor Yulin Chiang	Inventor's Signature <i>Yulin Chiang</i>	Date 6/5/2002
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Full Name of Fifth Inventor Edward J. Glamkowski	Inventor's Signature	Date
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